REMARKS

In response to the Office Action of May 26, 2005, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-45 are pending in this application. By this Amendment, Claims 1, 20 and 40 have been amended. Applicants respectfully submit that no new matter has been added to this application. Moreover, it is believed that the claims as presented herein places the application in condition for allowance.

The Examiner has objected to the specification for certain informalities, namely, including the serial number and filing date of the referenced patent application on page 17. The specification has been amended in a manner believed to obviate the Examiner's objection. Accordingly, withdrawal of the objection is respectfully requested.

The Examiner has objected to Claim 40 for the recitation "said means for receptacle moving means". Claim 40 has been amended in a manner believed to obviate the Examiner's objection. Accordingly, withdrawal of the objection is respectfully requested.

The Examiner has provisionally rejected Claims 1-3, 6, 7, 9, 11, 12, 14, 15, 19, 20, 22, 23, 26, 27, 29, 31, 32, 34, 35, and 38-45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 3-9, 15-19 and 24-30 of co-pending

Application No. 10/779,422. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1, 2, 13-18, 20-22 and 33-38 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 20 and 22-30 of co-pending Application No. 10/699,529. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1, 2, 13-17, 20, 22, 34-37, 39-42, 44 and 45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 3, 10-18, 22 and 23 of co-pending Application No. 10/699,508. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1, 2, 20, 22, 39, 41 and 44 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 13, 19-22 and 33-35 of co-pending Application No. 10/699,509. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has rejected Claims 39-42 under 35 U.S.C. §102(e) as being anticipated by Kolosov et al. U.S. Patent Application Publication No. 2004/0123650 ("Kolosov").

Nowhere does Kolosov disclose or suggest "a system for screening lubricant performance, under program control, comprising: (a) a plurality of test receptacles, each containing *a different lubricating oil composition sample comprising (a) a major amount of at*

least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive; (b) receptacle moving means for individually positioning said test receptacles in a testing station for measurement of storage stability in the respective sample; (c) means for measuring the storage stability in the sample moved to the testing station to obtain storage stability data associated with said sample and for transferring said storage stability data to a computer controller, wherein said computer controller is operatively connected to the means for individually moving the test receptacles" as presently recited in Claim 1.

Rather, Kolosov discloses a system and method for screening a library of a multitude of genera of material samples for rheological properties. The genera of material disclosed in Kolosov which can be tested include polymeric materials, organic materials, amorphous materials, crystalline materials, macromolecular materials, small-molecule materials, inorganic materials, pure materials, mixtures of the materials, any commercial product itself or an ingredient or portion within a commercial product such as pharmaceuticals, coatings, cosmetics, adhesives, inks, foods, crop agents, detergents, protective agents, and lubricants, as well as gels, oils, solvents, greases, creams, foams and other whipped materials, ointments, pastes, powders, films, particles, bulk materials, dispersions, suspensions, and emulsions. However, it is well established that for a claim to be anticipated a single prior art reference must disclose each and every element of the claimed invention. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, (Fed. Cir. 1987). At no point is there any disclosure in Kolosov of a system for screening lubricant performance, under program control, comprising, *inter alia*, (a) a plurality of test receptacles, each containing *a different lubricating oil composition sample comprising (a) a major amount of at least one base oil of lubricating*

viscosity and (b) a minor amount of at least one lubricating oil additive, (b) receptacle moving means for individually positioning said test receptacles in a testing station for measurement of storage stability in the respective sample; (c) means for measuring the storage stability in the sample moved to the testing station to obtain storage stability data associated with said sample and for transferring said storage stability data to a computer controller, wherein said computer controller is operatively connected to the means for individually moving the test receptacles." As such, Claims 39-42 clearly possess novel subject matter relative to Kolosov. Accordingly, withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

The Examiner has rejected Claims 1-9, 18-29, 38 and 43 under 35 U.S.C. §103 (a) as being obvious over Kolosov in view of both O'Rear U.S. Patent Application Publication No. 2003/0100453 ("O'Rear") and Tolvanen et al. U.S. Patent No. 5,715,046 ("Tolvanen").

Nowhere does Kolosov disclose or suggest a high throughput method for screening lubricating oil additive composition samples, under program control, comprising (a) providing a plurality of different lubricating oil additive composition samples comprising at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) maintaining each sample at a predetermined temperature for a predetermined time; (c) measuring the storage stability of each sample to provide storage stability data for each sample; and, (d) outputting the results of step (c) as presently recited in Claim 1. Nor is there any disclosure or suggestion in Kolosov of a high throughput method for screening lubricating oil composition samples, under program control, comprising (a) providing a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, each sample

being in a respective one of a plurality of test receptacles; (b) maintaining each sample at a predetermined temperature for a predetermined time; (c) measuring the storage stability of each sample to provide storage stability data for each sample; and, (d) outputting the results of step (c) as presently recited in Claim 20.

Rather, Kolosov discloses a system and method for screening a library of a multitude of genera of material samples for rheological properties. The genera of material disclosed in Kolosov which can be tested include polymeric materials, organic materials, amorphous materials, crystalline materials, macromolecular materials, small-molecule materials, inorganic materials, pure materials, mixtures of the materials, any commercial product itself or an ingredient or portion within a commercial product such as pharmaceuticals, coatings, cosmetics, adhesives, inks, foods, crop agents, detergents, protective agents, and lubricants, as well as gels, oils, solvents, greases, creams, foams and other whipped materials, ointments, pastes, powders, films, particles, bulk materials, dispersions, suspensions, and emulsions.

In addition to testing the rheological properties of the broad categories of flowable material, Kolosov discloses that other properties may be tested and includes a large number of broad tests such as density, melt index, thermal degradation, aging characteristics, weight-average molecular weight, number-average molecular weight, viscosity-average molecular weight, peak molecular weight, approximate molecular weight, polydispersity index, molecular-weight-distribution shape, relative or absolute component concentration, conversion, concentration, mass, hydrodynamic radius, radius of gyration, chemical composition, amounts of residual monomer, presence and amounts of other low-molecular weight impurities in samples, particle or molecular size, intrinsic viscosity, molecular shape, molecular conformation, and/or

agglomeration or assemblage of molecules. According to Kolosov, any of the genera of flowable material can be subjected to any of the plurality of tests disclosed.

However, at no point is there any appreciation in Kolosov of screening lubricating oil additive composition samples or, for that matter, lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, under program control, by maintaining each sample at a predetermined temperature for a predetermined time; measuring the storage stability of each sample to provide storage stability data for each sample; and outputting the results. Thus, nothing in Kolosov would lead one skilled in the art to modify the system and method for testing the genera of flowable material with any of the broad tests disclosed therein and arrive at the specifically recited high throughput method for screening lubricating oil additive composition samples, under program control, comprising (a) providing a plurality of different lubricating oil additive composition samples comprising at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) maintaining each sample at a predetermined temperature for a predetermined time; (c) measuring the storage stability of each sample to provide storage stability data for each sample; and, (d) outputting the results of step (c) as presently recited in Claim 1. Also, nothing in Kolosov would lead one skilled in the art to modify the system and method for testing the genera of flowable material with any of the broad tests disclosed therein and arrive at the specifically recited high throughput method for screening lubricating oil composition samples, under program control, comprising (a) providing a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive,

each sample being in a respective one of a plurality of test receptacles; (b) maintaining each sample at a predetermined temperature for a predetermined time; (c) measuring the storage stability of each sample to provide storage stability data for each sample; and, (d) outputting the results of step (c) as presently recited in Claim 20.

O'Rear fails to cure the deficiencies of Kolosov. Specifically, nowhere does O'Rear disclose a high throughput method for screening lubricating oil additive composition samples, under program control, comprising (a) providing a plurality of different lubricating oil additive composition samples comprising at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) maintaining each sample at a predetermined temperature for a predetermined time; (c) measuring the storage stability of each sample to provide storage stability data for each sample; and, (d) outputting the results of step (c). Nor does O'Rear disclose or suggest a high throughput method for screening lubricating oil composition samples, under program control, comprising (a) providing a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) maintaining each sample at a predetermined temperature for a predetermined time; (c) measuring the storage stability of each sample to provide storage stability data for each sample; and, (d) outputting the results of step (c) as presently recited in Claim 20.

Rather, O'Rear discloses a blend of synthetic and non-synthetic lube base oils wherein the lube base oil product has a greater stability in the absence of additives than the stability of the synthetic lube base oil and has a greater stability in the presence of additives than the non-

synthetic lube base oil. O'Rear further discloses that the blend of lube base oils may or may not contain one or more additives. It is not seen where in O'Rear there is any suggestion, motivation or even a hint of a high throughput method for screening a plurality of lubricating oil additive composition samples or, for that matter, a high throughput method for screening a plurality of lubricating oil composition samples, under program control, by maintaining each sample at a predetermined temperature for a predetermined time; measuring the storage stability of each sample to provide storage stability data for each sample; and outputting the results. Instead, O'Rear is merely concerned with forming a blend of lube base oils wherein the lube base oil product has a greater stability in the absence of additives than the stability of the synthetic lube base oil and has a greater stability in the presence of additives than the non-synthetic lube base oil. Thus, nothing in O'Rear would lead one skilled in the art to modify the system and method of Kolosov by looking to the disclosure of O'Rear and arrive at the claimed high throughput method for screening lubricating oil additive compositions. Also, nothing in O'Rear would lead one skilled in the art to modify the system and method of Kolosov by looking to the disclosure of O'Rear and arrive at the claimed high throughput method for screening lubricating oil compositions.

Tolvanen does not cure and is not cited as curing the foregoing deficiencies of Kolosov and O'Rear. Instead, Tolvanen is cited for its disclosure that the stability of lubricating oil compositions can be determined by measuring the intensity of light scattering from the oil sample surface. Thus, nothing in Tolvanen would lead one skilled in the art to modify the method of Kolosov and O'Rear by looking to the disclosure of Tolvanen and arrive at the claimed high throughput method for screening lubricating oil additive compositions. Also,

nothing in Tolvanen would lead one skilled in the art to modify the method of Kolosov and O'Rear by looking to the disclosure of Tolvanen and arrive at the claimed high throughput method for screening lubricating oil compositions.

With respect to Claim 43, nowhere does Kolosov disclose or suggest a system for screening lubricant performance, under program control, comprising (a) a plurality of test receptacles, each containing a different lubricating oil composition sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) receptacle moving means for individually positioning said test receptacles in a testing station for measurement of storage stability in the respective sample; and (c) means for measuring the storage stability in the sample moved to the testing station to obtain storage stability data associated with said sample and for transferring said storage stability data to a computer controller, wherein said computer controller is operatively connected to the means for individually moving the test receptacles as presently recited in Claim 39 from which Claim 43 ultimately depends. Moreover, there is nothing in Kolosov that discloses or suggests a system for screening lubricant performance, under program control, wherein the testing station includes a light source and a photocell aligned with the light source as presently recited in Claim 43.

Rather, Kolosov discloses a system and method for screening a library of a multitude of genera of material samples for rheological properties. The genera of material disclosed in Kolosov which can be tested include polymeric materials, organic materials, amorphous materials, crystalline materials, macromolecular materials, small-molecule materials, inorganic materials, pure materials, mixtures of the materials, any commercial product itself or an ingredient or portion within a commercial product such as pharmaceuticals, coatings, cosmetics,

adhesives, inks, foods, crop agents, detergents, protective agents, and lubricants, as well as gels, oils, solvents, greases, creams, foams and other whipped materials, ointments, pastes, powders, films, particles, bulk materials, dispersions, suspensions, and emulsions.

In addition to testing the rheological properties of the genera of flowable material, Kolosov discloses that other properties may be tested and includes a large number of broad tests such as density, melt index, thermal degradation, aging characteristics, weight-average molecular weight, number-average molecular weight, viscosity-average molecular weight, peak molecular weight, approximate molecular weight, polydispersity index, molecular-weight-distribution shape, relative or absolute component concentration, chemical composition, conversion, concentration, mass, hydrodynamic radius, radius of gyration, amounts of residual monomer, presence and amounts of other low-molecular weight impurities in samples, particle or molecular size, intrinsic viscosity, molecular shape, molecular conformation, and/or agglomeration or assemblage of molecules. According to Kolosov, any of the genera of flowable material can be subjected to any of the plurality of tests disclosed.

However, at no point is there any appreciation in Kolosov of a system for screening lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, under program control, by measuring the storage stability of each sample; and outputting the results. Thus, nothing in Kolosov would lead one skilled in the art to modify the system and method for testing the rheological properties of the genera of flowable material and arrive at the recited system for screening lubricating oil composition samples of Claim 39.

O'Rear fails to cure the deficiencies of Kolosov. Specifically, nowhere does O'Rear disclose a high throughput system for screening lubricating oil composition samples, under program control, comprising (a) a plurality of test receptacles, each containing a different lubricating oil composition sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) receptacle moving means for individually positioning said test receptacles in a testing station for measurement of storage stability in the respective sample; and (c) means for measuring the storage stability in the sample moved to the testing station to obtain storage stability data associated with said sample and for transferring said storage stability data to a computer controller, wherein said computer controller is operatively connected to the means for individually moving the test receptacles as presently recited in Claim 39. Moreover, there is nothing in O'Rear that discloses or suggests a system for screening lubricant performance, under program control, wherein the testing station includes a light source and a photocell aligned with the light source as presently recited in Claim 43.

Rather, O'Rear merely discloses a blend of synthetic and non-synthetic lube base oils wherein the lube base oil product has a greater stability in the absence of additives than the stability of the synthetic lube base oil and has a greater stability in the presence of additives than the non-synthetic lube base oil. O'Rear further discloses that the blend of lube base oils may or may not contain one or more additives. It is not seen where in O'Rear there is any suggestion, motivation or even a hint of a high throughput system for screening a plurality of lubricating oil composition samples, under program control. Instead, O'Rear is concerned with forming a blend of lube base oils wherein the lube base oil product has a greater stability in the absence of

additives than the stability of the synthetic lube base oil and has a greater stability in the presence of additives than the non-synthetic lube base oil. Thus, nothing in O'Rear would lead one skilled in the art to modify the system and method of Kolosov by looking to the disclosure of O'Rear and arrive at the claimed system for screening lubricating oil compositions.

Tolvanen does not cure and is not cited as curing the foregoing deficiencies of Kolosov and O'Rear. Instead, Tolvanen is cited for its disclosure that the stability of lubricating oil compositions can be determined by measuring the intensity of light scattering from the oil sample surface. Thus, nothing in Tolvanen would lead one skilled in the art to modify the system and method of Kolosov and O'Rear by looking to the disclosure of Tolvanen and arrive at the claimed system for screening lubricating oil composition samples.

For the foregoing reasons, Claims 1-9, 18-29, 38 and 43 are believed to be nonobvious, and therefore patentable, over Kolosov, O'Rear and Tolvanen, no matter how these references are considered.

The Examiner has rejected Claims 10-13, 30-33, 44 and 45 under 35 U.S.C. §103 (a) as being obvious over Kolosov in view of O'Rear and Tolvanen and further in view of Garr et al. U.S. Patent No. 5,993,662 ("Garr").

The foregoing deficiencies of Kolosov, O'Rear and Tolvanen discussed above with respect to the rejections of Claims 1, 20 and 39 apply with equal force to this rejection. Garr does not cure and is not cited as curing the above-noted deficiencies of Kolosov, O'Rear and Tolvanen. Rather, Garr is simply cited for the disclosure of employing a bar code to identify individual containers. Accordingly, Claims 10-13, 30-33, 44 and 45 are believed to be nonobvious, and therefore patentable, over Kolosov, O'Rear, Tolvanen and Smrcka.

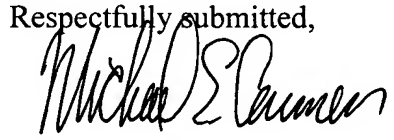
The Examiner has rejected Claims 14-17 and 34-37 under 35 U.S.C. §103 (a) as being obvious over Kolosov in view of O'Rear and Tolvanen and further in view of Smrcka et al. European Patent Application No. 1,233,361 ("Smrcka").

The foregoing deficiencies of Kolosov, O'Rear and Tolvanen discussed above with respect to the rejections of Claims 1 and 20 apply with equal force to this rejection. Smrcka does not cure and is not cited as curing the above-noted deficiencies of Kolosov, O'Rear and Tolvanen. Rather, Smrcka is merely cited for its disclosure of storing test results in a data carrier.

Since Kolosov, O'Rear, Tolvanen and Smrcka, alone or in combination, do not disclose or suggest the high throughput methods of Claims 1 and 20 from which Claims 14-17 and 34-37 ultimately depend, Claims 14-17 and 34-37 are believed to be nonobvious, and therefore patentable, over Kolosov, O'Rear, Tolvanen and Smrcka.

For the foregoing reasons, Claims 1-45 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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